

AMENDMENT UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 3627
PATENT
ATTORNEY DOCKET NO. 2000P7518 US (1009-026)
SERIAL NO. 09/528,693

REMARKS

Claims 1-6 are now pending in this application. Claim 1 is the independent claim.

I. The Anticipation Rejections

Claims 1-6 were rejected as anticipated under 35 U.S.C. §102. In support of the rejection, various references were cited. Each of these rejections is respectfully traversed.

The 37 CFR § 1.132 Declaration of Dr. Ronald D. Williams (hereinafter referred to as “the Williams Declaration), filed herewith, indicates that one skilled in the art would not find all of the elements and limitations of the claims present in any the cited references.

As explained below, the cited references fail to establish a prima facie case of anticipation. See MPEP 2131. To anticipate expressly, the “invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior art reference, arranged as in the claim”. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001). The single reference must describe the claimed subject matter “with sufficient clarity and detail to establish that the subject matter existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention”. *Crown Operations Int’l, LTD v. Solutia Inc.*, 289 F.3d 1367, 1375, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002). Moreover, the prior art reference must be sufficient to enable one with ordinary skill in the art to practice the claimed invention. *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (C.C.P.A. 1965), *cert. denied*, 382 U.S. 973 (1966); *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354 (Fed. Cir. Jan. 6, 2003) (“A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.”)

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A. The Rejection citing Cragun

Claims 1-6 were rejected as anticipated under 35 U.S.C. §102(b). In support of the rejection, Cragun (U.S. Patent No. 5,804,803) was cited. This rejection is respectfully traversed.

Claim 1 cites “a programmable logic controller”. Definitions of the term “programmable logic controller”, as understood by one having ordinary skill in the art at the time of the application, are presented in the Williams Declaration paragraphs 16-17. In view of the definitions from the Williams Declaration, Cragun does not expressly or inherently teach or suggest “a programmable logic controller”.

Applicant interprets the omission of any mention of a “programmable logic controller” in paragraph 4 of the present Office Action to mean that the USPTO agrees that this element is not present in Cragun.

Accordingly, it is respectfully submitted that the rejection of claim 1 is unsupported by Cragun and should be withdrawn. In addition, the rejection of claims 2-6, each ultimately depending from independent claim 1, is unsupported by Cragun and should be withdrawn.

B. The Rejection citing Reber

Claims 1-6 were rejected as anticipated under 35 U.S.C. §102(e). In support of the rejection, Reber et al. (U.S. Patent No. 5,940,595) was cited. This rejection is respectfully traversed.

Claim 1 cites “a programmable logic controller”. Paragraphs 22-24 of the Williams Declaration evidence that one skilled in the art would not find that Reber teaches “a programmable logic controller”. Accordingly, it is respectfully submitted that the rejection of claim 1 is unsupported by Reber and should be withdrawn. In addition, the rejection of claims 2-6, each ultimately depending from independent claim 1, is unsupported by Reber and should be withdrawn.

Accordingly, it is respectfully submitted that the rejection of claims 1-6 is unsupported by Reber and should be withdrawn.

II. The Obviousness Rejection

Claims 1-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Cragun et al. (U.S. Patent No. 5,804,803) in view of Ohanian et al. (U.S. Patent No. 6,109,526). These rejections are respectfully traversed.

Claims 1-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Hudetz et al. (U.S. Patent No. 5,978,773) in view of Ohanian et al. (U.S. Patent No. 6,109,526). These rejections are respectfully traversed.

As explained below, none of the cited references, either alone or in any combination, establish a *prima facie* case of obviousness. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.” See MPEP § 2143.

Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted.

A. Cragun in view of Ohanian

Claim 1, from which claims 2-6 depend, recites “a programmable logic controller”. Paragraphs 25-28 of the Williams Declaration evidence that one skilled in the art would find that

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Ohanian does not teach or suggest “a programmable logic controller”. Cragun does not overcome the deficiencies of Ohanian.

Thus, even if combinable or modifiable, the cited references do not expressly or inherently teach or suggest **every** limitation of the claims. Accordingly, it is respectfully submitted that Cragun in view of Ohanian does not render obvious independent claim 1. Because no *prima facie* rejection of independent claim 1 has been presented, no *prima facie* rejection of any claim dependent thereon can be properly asserted.

Consequently, reconsideration and withdrawal of the rejection of claims 1-6 is respectfully requested.

B. Ohanian in view of Hudetz

Claim 1, from which claims 2-6 depend, cites “a programmable logic controller”. Paragraphs 29-31 of the Williams Declaration evidence that one skilled in the art would find that Hudetz does not teach or suggest “a programmable logic controller”. Ohanian does not overcome the deficiencies of Hudetz.

Thus, even if combinable or modifiable, the cited references do not expressly or inherently teach or suggest **every** limitation of the claims. Accordingly, it is respectfully submitted that Ohanian in view of Hudetz does not render obvious independent claim 1. Because no *prima facie* rejection of independent claim 1 has been presented, no *prima facie* rejection of any claim dependent thereon can be properly asserted.

Consequently, reconsideration and withdrawal of the rejection of claims 1-6 is respectfully requested.

III. Definitions

Definitions recited in paragraph 19 of the Office Action, dated 30 July 2003, and implicitly referenced in the present office action, are yet again respectfully traversed. As recognized in a previous Office Action, “[T]here is a heavy presumption in favor of the ordinary meaning of claim language **as understood by one of ordinary skill in the art.**” *CCS Fitness Inc. v. Brunswick Corp.*, 288 F. 3d 1359, 1366 (Fed. Cir. 2002). Further:

When not defined by applicant in the specification, the words of a claim must be given their plain meaning. In other words, **they must be read as they would be interpreted by those of ordinary skill in the art.** *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001)(explaining the court's analytical process for determining the meaning of disputed claim terms); *Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1299, 53 USPQ2d 1065, 1067 (Fed. Cir. 1999)(“Words in patent claims are given their ordinary meaning in the usage of the field of the invention, unless the text of the patent makes clear that a word was used with a special meaning.”). See also, *In re Sneed*, 710 F.2d 1544, 218 USPQ 385 (Fed. Cir. 1983)

See MPEP § 2111.01.

No Office Action related to Application 09/528,693 has provided even a shred of evidence linking the USPTO’s proffered definitions (as recited in paragraph 11 of the Williams Declaration) to “the ordinary meaning of claim language as understood by one of ordinary skill in the art”. As indicated in paragraphs 12 and 13 of the Williams Declaration, no support, factual or otherwise, has been presented supporting the definition of a “programmable logic controller” found in the Office Actions.

Paragraphs 16-17 of the Williams Declaration, however, do provide definitions providing “the ordinary meaning” of the claim term “Programmable Logic Controller (PLC)” and paragraph 18 evidences that these definitions are consistent with the understanding of “one of ordinary skill in the art.”

For further evidence of the meaning of “programmable logic controller”, one having ordinary skill in the art could look to descriptions of programmable logic controller design,

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ATTORNEY DOCKET NO. 2000P7518 US (1009-026)
SERIAL NO. 09/528,693

application, and/or use in thousands of issued patents. A small subset of patents providing support for the definitions from the Williams Declaration comprise: 6,392,557, 6,354,113, 6,349,235, 6,324,057, 6,172,875, 6,151,625, 6,141,628, 6,128,202, 6,021,356, 6,008,548, 5,978,593, 5,947,748, 5,923,903, 5,867,383, 5,815,659, 5,809,319, 5,802,389, 5,765,000, 5,731,595, 5,727,170, 5,713,036, 5,659,705, 5,615,104, 5,276,811, 5,237,652, 5,225,975, 5,157,590, 5,155,664, 5,142,469, 5,099,391, 5,058,052, 5,056,001, 5,038,318, 4,969,083, 4,910,659, 4,675,843, 4,404,625, 4,381,456, 4,275,455, 4,178,634, 3,982,230, 3,975,622, 3,953,834, and 3,942,158.

The present Office Action, dated 18 May 2004, contains the following statement (referring to a previous Declaration of Dr. Williams filed responsive to the Office Action dated 17 December 2003): “[a]lthough the Williams Declaration states the Examiner’s definition is incorrect, the Williams Declaration fails to state why the Examiner’s definitions are not proper in this context. Moreover, not only does the Williams Declaration fail to provide objective evidence as to why the Examiner’s definitions are improper, the Williams Declaration fails to provide evidence as to why Dr. Williams definitions should be controlling”.

Paragraphs 19-21 of the Williams Declaration discuss this statement. Applicant respectfully submits that the definition heretofore used in the Office Actions for “programmable logic controller” is improper because it fails to meet the legal standard that claims “must be read as they would be interpreted by those of ordinary skill in the art”. MPEP § 2111.01.

Specifically, the Office Action dated 30 July 2003, upon which every subsequent Office Action relies, asserts that “[i]t is the Examiner [sic] factual determination that a programmable logic controller is a PLD.” Notably, 30 July 2003 Office Action provides no reason, factual or otherwise, for why “the Examiner” equated a “programmable logic controller” with a “PLD”. Moreover, the 30 July 2003 Office Action provides no showing that **one skilled in the art** would equate a “programmable logic controller” with a “PLD”. Thus, no evidence has been

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EXAMINING GROUP 3627
PATENT
ATTORNEY DOCKET NO. 2000P7518 US (1009-026)
SERIAL NO. 09/528,693

presented why the definition of a “programmable logic controller” in the Office Actions should be controlling.

In contrast, Applicant has provided ample evidence regarding why the definitions contained in the Williams Declaration should be controlling.

IV. Lexicography

To the extent that any claim rejection relies on paragraph 9 of the present Office Action, Applicant respectfully traverses, and requests an identification of the rejected claim.

V. Means Plus Function Statements

Applicant expresses appreciation for the recognition, on page 9 of the present Office Action, that there is corresponding structure for the means element of claim 6. Applicant further expresses appreciation for the repeated recognition, on page 10 of the present Office Action, that “the means-plus-function limitation in claim 6 is not the claim’s only point of novelty”, thus indicating that claim 6 is allowable.

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CONCLUSION

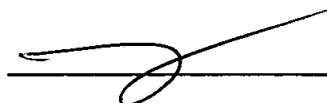
It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

Michael Haynes PLC

Date: 6 August 2004

A handwritten signature in dark ink, appearing to read 'Michael N. Haynes', is written over a horizontal line.

Michael N. Haynes
Registration No. 40,014

1341 Huntersfield Close
Keswick, VA 22947
Telephone: 434-972-9988
Facsimile: 413-375-4232